

REMARKS/ARGUMENTS

Claims 1, 3-17, 19-25, 27-31 and 33-37 are pending in the present application. In the Office Action mailed June 7, 2006, the Examiner rejected claims 1, 3-17, 19-25, 27-31 and 33-37 under 35 U.S.C. § 103. Claims 1, 17, 25, and 31 have been amended. Claims 4, 11, 19, 24, 27, 30, 33, and 37 have been cancelled. Claims 2, 18, 26, and 32 were previously cancelled.

Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

A. Rejection of Claims 1, 3-17, 19-24, 31 and 33-37 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 3-17, 19-24, 31 and 33-37 under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,634,114 to Shipley (hereinafter, "Shipley") in view of U.S. Patent No. 6,185,734 to Saboff et al. (hereinafter, "Saboff") and further in view of U.S. Patent No. 5,590,056 to Barritt (hereinafter, "Barritt"). Claims 4, 11, 19, 24, 33, and 37 have been cancelled. With respect to the remaining claims, this rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

Claims 1, 17, 25, and 31 have been amended to recite “obtaining information relating to the at least one of the plurality of application programs and the corresponding at least one designated software code by automated examination of the executable code and entering the information into the database.” Support for this amendment may be found throughout Applicants’ specification, such as on page 9, lines 9-15 and cancelled claims 4, 19, 27, and 33.

Applicants respectfully submit that the Office Action’s proposed combination of Shipley, Saboff, and Barritz does not disclose, teach, or suggest all of the limitations in claims 1, 17, 25, and 31. Specifically, none of the cited references disclose, teach, or suggest “obtaining information relating to … the corresponding at least one designated software code by automated examination of the executable code,” as recited in claims 1, 17, 25, and 31.

The Office Action asserts that Barritz discloses “obtaining information relating to … the corresponding at least one designated software code by automated examination of the executable code” because Barritz “shows a surveying program for periodically obtaining information relating to the plurality of application programs by automated examination.” Office Action, page 6. In support of this assertion, the Office Action cited various portions of Barritz. See id.

The first portion of Barritz the Office Action cited states, “[t]he surveying program 12 examines all the storage devices 14, 16 and 18 on computer system 10 to determine the program modules present.” Barritz, col. 4, lines 44-47. Apparently the Office Action is asserting that determining the presence of program modules, as disclosed by Barritz, is the same as “obtaining information,” as recited in claims 1, 17, 25, and 31.

However, determining the presence of program modules is not “obtaining information relating to … the corresponding at least one designated software code by automated examination of the executable code,” as recited in claims 1, 17, 25, and 31. Barritz equates program modules with executable files. See id. at col. 4, lines 27-28 (“As used in this document, the term program or program module is used synonymously with executable file.”). Therefore, Barritz discloses

determining the presence of executable files. However, executable files and “software code,” as recited in claims 1, 17, 25, and 31, are not the same. Therefore, this first portion of Barritz does not disclose, teach, or suggest “obtaining information relating to … the corresponding at least one designated software code by automated examination of the executable code,” as recited in claims 1, 17, 25, and 31.

The second cited portion of Barritz states, “[t]he surveying program 12 surveys storage devices 14, 16 and 18 when requested to do so by an operator (e.g. interactive user 26), any other program (e.g., the monitoring program 22), or periodically.” Barritz, col. 4, lines 50-53. The surveying program 12 in this portion is the same as the surveying program in the first cited portion. Applicants respectfully submit that merely surveying storage devices for executable files, periodically or otherwise, is not the same as “obtaining information relating to … the corresponding at least one designated software code by automated examination of the executable code,” as recited in claims 1, 17, 25, and 31. Therefore, this second portion of Barritz does not disclose, teach, or suggest this limitation.

The third cited portion of Barritz states, “[i]n a preferred embodiment, the directory surveyor 12A reads the directory 70 of the storage devices 14, 15 and 16, and ascertains which entries represent executable files on the basis of the entries 70a, 70b . . . 70n in the directory 70.” Barritz, col. 5, lines 13-16. Applicants again assert that executable files are not the same as “software code,” as recited in claims 1, 17, 25, and 31. Therefore, this third portion of Barritz does not disclose, teach, or suggest “obtaining information relating to … the corresponding at least one designated software code by automated examination of the executable code,” as recited in claims 1, 17, 25, and 31.

Applicants respectfully submit that none of the cited portions of Barritz discloses, teaches, or suggests this limitation. Therefore, the Office Action has not cited, nor can Applicants find, any portion of Barritz that discloses, teaches, or suggests “obtaining information relating to … the corresponding at least one designated software code by automated examination of the executable code,” as recited in claims 1, 17, 25, and 31. Furthermore, the Office Action has not cited, nor can

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Applicants find, any portion of Shipley or Saboff that discloses, teaches, or suggests this limitation. Consequently, the Office Action has not established a *prima facie* case of obviousness against claims 1, 17, 25, and 31.

In view of the foregoing, Applicants respectfully submit that claims 1, 17, 25, and 31 are patentably distinct from the cited references. Accordingly, Applicants respectfully request that the rejection of claims 1, 17, 25, and 31 be withdrawn.

Claims 3, 5-10, and 12-16 depend either directly or indirectly from claim 1. Claims 20-23 depend either directly or indirectly from claim 17. Claims 28-29 depend either directly or indirectly from claim 25. Claims 34-36 depend either directly or indirectly from claim 31. Accordingly, Applicants respectfully request that the rejection of claims 3, 5-10, 12-16, 20-23, 28-29, and 34-36 be withdrawn for at least the same reasons as those presented above in connection with claims 1, 17, 25, and 31.

B. Rejection of Claims 25 and 27-30 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 25 and 27-30 under 35 U.S.C. § 103(a) based on Shipley in view of Saboff further in view of Barritz and further in view of U.S. Patent No. 5,960,204 to Yinger et al. (hereinafter, "Yinger"). Claims 27 and 30 have been cancelled. With respect to the remaining claims, this rejection is respectfully traversed.

The standard for establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a) is provided above. Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

As shown above, the Office Action has not cited, nor can Applicants find, any portion of Barritz, Shipley, or Saboff that discloses, teaches, or suggests "obtaining information relating to ... the corresponding at least one designated software code by automated examination of the executable code," as recited in claim 25. Furthermore, the Office Action has not cited, nor can Applicants find,

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any portion of Yinger that discloses, teaches, or suggests this limitation. Consequently, the Office Action has not established a *prima facie* case of obviousness against claim 25.

In view of the foregoing, Applicants respectfully submit that claim 25 is patentably distinct from the cited references. Accordingly, Applicants respectfully request that the rejection of claim 25 be withdrawn.

Claims 28-29 depend either directly or indirectly from claim 25. Accordingly, Applicants respectfully request that the rejection of claims 28-29 be withdrawn for at least the same reasons as those presented above in connection with claim 25.

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C. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



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